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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/838,983	04/20/2001	David A. Hughes	SNY-P4339	1235

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MILLER PATENT SERVICES  
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RALEIGH, NC 27606

EXAMINER
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BATURAY, ALICIA

ART UNIT	PAPER NUMBER
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2146

MAIL DATE	DELIVERY MODE
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05/23/2008

PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b> 09/838,983	<b>Applicant(s)</b> HUGHES ET AL.	
	<b>Examiner</b> Alicia Baturay	<b>Art Unit</b> 2146	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 11 March 2008.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-51 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-51 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 26 November 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |                                                                                                                        |                                                                                         |
|------------------------------------------------------------------------------------------------------------------------|-----------------------------------------------------------------------------------------|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)                                            | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftperson's Patent Drawing Review (PTO-948)                                    | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____                                                |

### **DETAILED ACTION**

1. This Office Action is in response to the amendment filed 11 March 2008.
2. Claims 1, 9, 17, 24, 31, 36, 42 and 47 were amended.
3. Claims 1-51 are pending in this Office Action.

### ***Response to Amendment***

4. Applicant's amendments and arguments with respect to claims 1-51 filed on 11 March 2008 have been fully considered but they are deemed to be moot in view of the new grounds of rejection.

### ***Claim Rejections - 35 USC § 103***

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claims 1, 2, 8-10, 17, 18, 24, 25, 36, 37 and 41-43 are rejected under 35 U.S.C. 103(a) as being unpatentable over Walsh (U.S. 7,296,060) in view of Kelly (U.S. 6,442,595).

Walsh teaches the invention substantially as claimed including a system and method for attaching a related document to a primary document which includes at least one word. The system includes a processor determining whether the plurality of words in the primary

document includes an indicator that the related document should be attached to the primary document. If an indicator is detected, the related document is then attached to the primary document for further processing. The processor may also identify at least one of a filename and a location of the related document to provide further functionality (see Abstract).

7. With respect to claim 1, Walsh teaches a method of transmitting an audio sample using electronic mail, comprising: establishing a file to be a predetermined default file to be used in conjunction with an email application program (Walsh, col. 6, lines 1-14); within the email application program, providing a platform for a sender to generate an electronic mail message to a recipient (Walsh, col. 3, lines 27-37); within the email application program, receiving a single command from the sender to attach the file; and responsive to the sender's command within the email application program to attach the file, attaching the file to the electronic mail message (Walsh, col. 3, lines 38-62).

Walsh does not explicitly teach the use of an audio sample.

However, Kelly teaches automatically attaching a file to a mail message (Kelly, col. 5, lines 12-19) where that file can be audio (Kelly, col. 6, lines 38-41).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Walsh in view of Kelly in order to enable the use of an audio sample. One would be motivated to do so in order to facilitate the sending of email attachments (Kelly, col. 5, lines 41-43).

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8. With respect to claim 2, Walsh teaches the invention described in claim 1, including a method of transmitting an audio sample using electronic mail, comprising: establishing a file to be a predetermined default file to be used in conjunction with an email application program (Walsh, col. 6, lines 1-14); within the email application program, providing a platform for a sender to generate an electronic mail message to a recipient (Walsh, col. 3, lines 27-37); within the email application program, receiving a single command from the sender to attach the file; and responsive to the sender's command within the email application program to attach the file, attaching the file to the electronic mail message (Walsh, col. 3, lines 38-62).

Walsh does not explicitly teach the use of an audio sample.

However, Kelly teaches the method wherein the audio sample comprises a computer file containing a compressed audio sample (Kelly, col. 5, lines 41-43).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Walsh in view of Kelly in order to enable the use of an audio sample. One would be motivated to do so in order to facilitate the sending of email attachments (Kelly, col. 5, lines 41-43).

9. With respect to claim 8, Walsh teaches the invention described in claim 1, including wherein the single command comprises clicking an icon (Walsh, col. 1, lines 45-50).
10. With respect to claim 9, Walsh teaches a method of transmitting an audio sample using electronic mail comprising: establishing a file to be a predetermined default file to be used in

conjunction with an email application program (Walsh, col. 6, lines 1-14); within the email application program, providing a platform for a sender to generate an electronic mail message to a recipient (Walsh, col. 3, lines 27-37); receiving a command from the sender to send the electronic mail message; and sending the electronic mail message along with the file to the recipient (Walsh, col. 3, lines 38-62).

Walsh does not explicitly disclose automatically attaching an audio sample to an email.

However, Kelly teaches within the email application program, automatically attaching an audio sample (Kelly, col. 6, lines 38-41) to each electronic mail message generated by the sender (Kelly, col. 5, lines 12-19).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Walsh in view Kelly in order to enable automatically attaching an audio sample to an email. One would be motivated to do so in order to facilitate the sending of email attachments (Kelly, col. 5, lines 41-43).

11. With respect to claim 24, Walsh teaches the invention described in claim 1, including an electronic mail system, comprising: a programmed processor; an electronic mail application running on the programmed processor, the electronic mail application having a user interface including a plurality of user controls to permit a sender to create and send an electronic mail message to a recipient (Walsh, col. 3, lines 27-62); and means for establishing a file to be a predetermined default file to be used in conjunction with an email application program (Walsh, col. 6, lines 1-14).

Walsh does not explicitly teach attaching a default audio sample.

However, Kelly teaches program means forming a part of the electronic mail application (Kelly, col. 5, lines 12-19), for attaching the predefined default audio sample to all electronic mail documents sent by the sender (Kelly, col. 6, lines 38-41).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Walsh in view of Kelly in order to enable the use of a default audio sample. One would be motivated to do so in order to facilitate the sending of email attachments (Kelly, col. 5, lines 41-43).

12. Claims 10, 17, 18, 25, 36, 37, 41-43 and 48 do not teach or define any new limitations above claims 1, 2, 8, 9 and 24 and therefore are rejected for similar reasons.
13. Claims 3, 5, 6, 11, 13, 14, 16, 19, 21, 22, 26, 28, 29, 31-35, 38-40 and 44-51 are rejected under 35 U.S.C. 103(a) as being unpatentable over Walsh in view of Kelly and in further view of Fritsch (U.S. 6,233,682).
14. With respect to claim 3, Walsh teaches the invention described in claim 2, including a method of transmitting an audio sample using electronic mail, comprising: establishing a file to be a predetermined default file to be used in conjunction with an email application program (Walsh, col. 6, lines 1-14); within the email application program, providing a platform for a sender to generate an electronic mail message to a recipient (Walsh, col. 3, lines 27-37); within the email application program, receiving a single command from the

sender to attach the file; and responsive to the sender's command within the email application program to attach the file, attaching the file to the electronic mail message (Walsh, col. 3, lines 38-62).

Walsh does not explicitly teach the use of an audio sample.

However, Kelly teaches automatically attaching a file to a mail message (Kelly, col. 5, lines 12-19) where that file can be audio (Kelly, col. 6, lines 38-41).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Walsh in view of Kelly in order to enable the use of an audio sample. One would be motivated to do so in order to facilitate the sending of email attachments (Kelly, col. 5, lines 41-43).

The combination of Walsh and Kelly does not explicitly teach the audio sample comprising a link to a source for purchase.

However, Fritsch teaches the method wherein the audio sample further comprises a link to a source for purchase of a product containing a representation of the audio sample (Fritsch, col. 4, lines 58-60).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the combination of Walsh and Kelly in view of Fritsch in order to enable the audio sample comprising a link to a source for purchase. One would be motivated to do so in order to facilitate the purchase of music online resulting in increased revenue via e-commerce (Fritsch, col. 1, lines 24-26).



15. With respect to claim 5, Walsh teaches the invention described in claim 1, including a method of transmitting an audio sample using electronic mail, comprising: establishing a file to be a predetermined default file to be used in conjunction with an email application program (Walsh, col. 6, lines 1-14); within the email application program, providing a platform for a sender to generate an electronic mail message to a recipient (Walsh, col. 3, lines 27-37); within the email application program, receiving a single command from the sender to attach the file; and responsive to the sender's command within the email application program to attach the file, attaching the file to the electronic mail message (Walsh, col. 3, lines 38-62).

Walsh does not explicitly teach the use of an audio sample.

However, Kelly teaches automatically attaching a file to a mail message (Kelly, col. 5, lines 12-19) where that file can be audio (Kelly, col. 6, lines 38-41).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Walsh in view of Kelly in order to enable the use of an audio sample. One would be motivated to do so in order to facilitate the sending of email attachments (Kelly, col. 5, lines 41-43).

The combination of Walsh and Kelly does not explicitly teach the audio sample comprising a link to streaming music.

However, Fritsch teaches the method wherein the audio sample comprises a link to a source of streaming music (Fritsch, col. 4, lines 49-58). Figure 1C shows a user "pre-listening" to a song on a web page; it is inherent the music is streaming.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the combination of Walsh and Kelly in view of Fritsch in order to enable the audio sample comprising a link to streaming music. One would be motivated to do so in order to facilitate the purchase of music online resulting in increased revenue via e-commerce (Fritsch, col. 1, lines 24-26).

16. With respect to claim 16, Walsh teaches the invention described in claim 9, including a method of transmitting an audio sample using electronic mail comprising: establishing a file to be a predetermined default file to be used in conjunction with an email application program (Walsh, col. 6, lines 1-14); within the email application program, providing a platform for a sender to generate an electronic mail message to a recipient (Walsh, col. 3, lines 27-37); receiving a command from the sender to send the electronic mail message; and sending the electronic mail message along with the file to the recipient (Walsh, col. 3, lines 38-62).

Walsh does not explicitly disclose automatically attaching an audio sample to an email.

However, Kelly teaches within the email application program, automatically attaching an audio sample (Kelly, col. 6, lines 38-41) to each electronic mail message generated by the sender (Kelly, col. 5, lines 12-19).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Walsh in view Kelly in order to enable automatically attaching an audio sample to an email. One would be motivated to do so in order to facilitate the sending of email attachments (Kelly, col. 5, lines 41-43).

The combination of Walsh and Kelly does not explicitly indicate that a server is being used to distribute the emails.

However, Fritsch teaches the method wherein the automatically attaching takes place in an enterprise electronic mail server (Fritsch, col. 3, lines 4-13).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the combination of Walsh and Kelly in view of Fritsch in order to enable the audio sample comprising a link to streaming music. One would be motivated to do so in order to facilitate the purchase of music online resulting in increased revenue via e-commerce (Fritsch, col. 1, lines 24-26).

17. With respect to claim 31, Walsh teaches an electronic mail system, comprising: a computer network; a programmed processor forming part of the computer network; an electronic mail application running on the programmed processor, the electronic mail application having a user interface including a plurality of user controls to permit a sender to create and send an electronic mail message to a recipient (Walsh, col. 3, lines 27-62) and means for establishing a file to be a predetermined default file to be used in conjunction with an email application program (Walsh, col. 6, lines 1-14).

Walsh does not explicitly teach the use of an audio sample.

However, Kelly teaches automatically attaching a file to a mail message (Kelly, col. 5, lines 12-19) where that file can be audio (Kelly, col. 6, lines 38-41).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Walsh in view of Kelly in order to enable the use of an audio sample.

One would be motivated to do so in order to facilitate the sending of email attachments (Kelly, col. 5, lines 41-43).

The combination of Walsh and Kelly does not explicitly teach an enterprise email server or a means on the mail server to attach a file to an outbound email.

However, Fritsch teaches an enterprise email server forming a part of the computer network, wherein email messages created using the electronic mail application are passed through the email server; and program means, running on the enterprise mail server, for attaching the audio sample to an electronic mail document sent from the electronic mail application to the recipient (Fritsch, col. 3, lines 4-13).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the combination of Walsh and Kelly in view of Fritsch in order to enable the use of an enterprise email server or a means on the mail server to attach a file to an outbound email. One would be motivated to do so in order to facilitate the purchase of music online resulting in increased revenue via e-commerce (Fritsch, col. 1, lines 24-26).

18. With respect to claim 32, Walsh teaches the invention described in claim 31, including an electronic mail system, comprising: a computer network; a programmed processor forming part of the computer network; an electronic mail application running on the programmed processor, the electronic mail application having a user interface including a plurality of user controls to permit a sender to create and send an electronic mail message to a recipient (Walsh, col. 3, lines 27-62) and means for establishing a file to be a predetermined default file to be used in conjunction with an email application program (Walsh, col. 6, lines 1-14).

Walsh does not explicitly teach the use of an audio sample.

However, Kelly teaches automatically attaching a file to a mail message (Kelly, col. 5, lines 12-19) where that file can be audio (Kelly, col. 6, lines 38-41) and the method wherein the audio sample comprises a computer file containing a compressed audio sample (Kelly, col. 5, lines 41-43).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Walsh in view of Kelly in order to enable the use of an audio sample. One would be motivated to do so in order to facilitate the sending of email attachments (Kelly, col. 5, lines 41-43).

19. Claims 6, 11, 13, 14, 19, 21, 22, 26, 28, 29, 33-35, 38-40 and 44-51 do not teach or define any new limitations above claims 3, 5, 16, 31 and 32 and therefore are rejected for similar reasons.

20. Claims 4, 7, 12, 15, 20, 23, 27 and 30 are rejected under 35 U.S.C. 103(a) as being unpatentable over Walsh in view of Kelly in view of Fritsch and in further view of Kang (U.S. 2001/0051925).

21. With respect to claim 4, Walsh teaches the invention described in claim 3, including a method of transmitting an audio sample using electronic mail, comprising: establishing a file to be a predetermined default file to be used in conjunction with an email application

program (Walsh, col. 6, lines 1-14); within the email application program, providing a platform for a sender to generate an electronic mail message to a recipient (Walsh, col. 3, lines 27-37); within the email application program, receiving a single command from the sender to attach the file; and responsive to the sender's command within the email application program to attach the file, attaching the file to the electronic mail message (Walsh, col. 3, lines 38-62).

Walsh does not explicitly teach the use of an audio sample.

However, Kelly teaches automatically attaching a file to a mail message (Kelly, col. 5, lines 12-19) where that file can be audio (Kelly, col. 6, lines 38-41).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Walsh in view of Kelly in order to enable the use of an audio sample. One would be motivated to do so in order to facilitate the sending of email attachments (Kelly, col. 5, lines 41-43).

The combination of Walsh and Kelly does not explicitly teach the audio sample comprising a link to a source for purchase.

However, Fritsch teaches the method wherein the audio sample further comprises a link to a source for purchase of a product containing a representation of the audio sample (Fritsch, col. 4, lines 58-60).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the combination of Walsh and Kelly in view of Fritsch in order to enable the audio sample comprising a link to a source for purchase. One would be motivated

to do so in order to facilitate the purchase of music online resulting in increased revenue via e-commerce (Fritsch, col. 1, lines 24-26).

The combination of Walsh, Kelly and Fritsch does not explicitly teach the use of affinity credit.

However, Kang teaches the method wherein if the recipient makes a purchase from the source, an affinity credit is awarded to the sender (Kang, paragraphs 29-30).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the combination of Walsh, Kelly and Fritsch in view of Kang in order to enable the use of affinity credit. One would be motivated to do so in order to encourage the wide distribution and purchase of content (Kang, paragraph 29).

22. Claims 7, 12, 15, 20, 23, 27 and 30 do not teach or define any new limitations above claim 4 and therefore are rejected for similar reasons.

***Conclusion***

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Alicia Baturay whose telephone number is (571) 272-3981. The examiner can normally be reached at 7:30am - 5pm, Monday - Thursday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jeffrey Pwu can be reached on (571) 272-6798. The fax number for the organization where this application or proceeding is assigned is (571) 273-8300.



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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Alicia Baturay  
May 24, 2008

/Jeffrey Pwu/  
Supervisory Patent Examiner, Art Unit 2146